

THIS DISPOSITION IS
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OF THE TTAB

Hearing:
July 14, 2005

Mailed: October 13, 2005

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re WM Distribution Inc.¹

Serial No. 78195284

Eugene Berman of Law Offices of Eugene Berman for WM
Distribution Inc.

M. Catherine Faint, Trademark Examining Attorney, Law
Office 103 (Michael Hamilton, Managing Attorney).

Before Hairston, Chapman and Grendel, Administrative
Trademark Judges.

Opinion by Chapman, Administrative Trademark Judge:

On December 17, 2002, Julie White filed an application
to register on the Principal Register the mark SANDIA for
"cigarette products, namely, cigarettes" in International
Class 34. The application was filed based on applicant's
assertion of her bona fide intention to use the mark in

¹ Application Serial No. 78195284 was filed by Julie White
(United States citizen), who assigned the application to WM
Distribution Inc. (a Delaware corporation). See Reel 2834, Frame
0929.

commerce. Julie White later filed an Amendment to Allege Use, with a claimed date of first use and first use in commerce of February 20, 2004, which was accepted by the USPTO.

The Examining Attorney has refused registration under Section 2(a) of the Trademark Act, 15 U.S.C. §1052(a), on the ground that applicant's mark "falsely suggests a connection with the federally recognized tribe of the Pueblo of Sandia, New Mexico." (Examining Attorney's brief, p. 2.)

When the refusal to register was made final, applicant appealed to the Board. Applicant and the Examining Attorney have filed briefs. An oral hearing was held on July 14, 2005.

Preliminarily, we address certain evidentiary matters. In applicant's brief (p. 3) it objects for the first time to evidence attached to the Examining Attorney's Office actions. The involved evidence consists of the results of Internet searches, and applicant has objected thereto on the ground that the search results do not include a date or source for the documents. The Examining Attorney contends that the objection should have been raised prior to the filing of applicant's brief. Further, the Examining Attorney explained (brief, p. 2) that several of the

Internet pages carried a date and URL source, albeit on a separate page; and that those pages without the source and date information were from a Trademark Law Library search.

Applicant's objection is untimely because if applicant had raised the objection promptly upon receipt of the Office actions with the involved attachments, the Examining Attorney may have been able to cure the defect. Applicant's objection to the Examining Attorney's Internet evidence is overruled.

The Examining Attorney objects in her brief (p. 3) to Exhibit 2 attached to applicant's brief (a table of the Examining Attorney's exhibits) on the basis that applicant's table incorrectly characterizes the evidence; and she "also objects to applicant's new exhibits to the brief because they are untimely."

The Examining Attorney did not specify whether she objects to all four exhibits, or if not, specifically which exhibits are the subject of her second objection. Applicant's exhibits attached to its brief are the following: Exhibit 1 -- table of exhibits submitted by applicant; Exhibit 2 -- table of exhibits submitted by the Examining Attorney; Exhibit 3 -- a summary of applicant's position on certain matters raised by the Examining Attorney (e.g., the Federal Trust Obligation, the Indian

Arts and Crafts Act); and Exhibit 4 -- a copy of applicant's specimen and a current version thereof.

The Board finds no harm in either an applicant or an Examining Attorney including in its brief charts of the evidence. However, we remain mindful of the Examining Attorney's view that applicant mischaracterizes the nature of some of the items listed thereon.

Applicant's position paper on trust principles is allowed as the Examining Attorney raised these matters.²

In this case, the Board finds no harm in allowing applicant's exhibit which shows the original specimen as well as a more current label (highly similar to the original).

The Examining Attorney's objections to applicant's exhibits attached to its brief are overruled.

The Examining Attorney requests (brief, footnote 6) that the Board take judicial notice of a "Bartleby.com" entry from The Columbia Gazetteer of North America (2000) for the purpose of showing that the page remains unchanged from the time it was previously submitted into the record by the Examining Attorney. The request is granted. See TBMP §704.12 (2nd ed. rev. 2004).

² The Examining Attorney withdrew her reliance on the Trust obligation. (Brief, p. 9.)

Applicant's request at the oral hearing that the Board take judicial notice of further pages from "Bartleby.com" provided for the first time at the hearing is denied.

We now turn to the merits of the case.

The issue before the Board in this application is whether applicant's mark SANDIA, as applied to the goods (cigarettes), falsely suggests a connection with the "federally recognized tribe of the Pueblo of Sandia, New Mexico" within the meaning of Section 2(a) of the Trademark Act, 15 U.S.C. §1052(a).

As discussed by our primary reviewing Court in the case of *University of Notre Dame du Lac v. J.C. Gourmet Food Imports Co., Inc.*, 703 F.2d 1372, 217 USPQ 505 (Fed. Cir. 1983), the portion of Section 2(a) dealing with false suggestion of a connection resulted from the desire to give statutory effect to the notions of the rights of privacy and publicity, the elements of which are distinctly different from the elements of a trademark infringement claim of likelihood of confusion, which is the essence of Section 2(d) of the Trademark Act. Specifically, the Court stated as follows (footnote omitted):

Under concepts of the protection of one's "identity," in any of the forms which have so far been recognized, the initial and critical requirement is that the name (or an equivalent

thereof) claimed to be appropriated by another must be unmistakably associated with a particular personality or "persona." ...

Thus, to show an invasion of one's "persona," it is not sufficient to show merely prior identification with the name adopted by another. Nor is it sufficient, as urged by the University, that the fame of the name of an institution provides the basis for protection in itself. The mark, NOTRE DAME, as used by Gourmet, must point uniquely to the University.

217 USPQ at 509.

Following the University of Notre Dame case, the Board enumerated the elements necessary to establish a claim under Section 2(a) (false suggestion of a connection) or to test the propriety of a refusal to register a mark based thereon. The elements are that: (i) applicant's mark (or part of it) must be shown to be the same as or a close approximation of the "person's"³ previously used name or identity; (ii) applicant's mark would be recognized as such (i.e., the mark points uniquely and unmistakably to that person); (iii) the person in question is not connected with the goods or services of the applicant; and (iv) the person's name or identity is of sufficient fame that when

³ The Board clarifies that throughout this decision our use of the term "person" may refer to a natural person, and/or a group of such people, and/or a juristic person. See Section 45 of the Trademark Act, 15 U.S.C. §1127.

it is used as all or part of applicant's mark for its goods or services, a connection with that person would be presumed by purchasers and potential purchasers. See *Buffett v. Chi-Chi's, Inc.*, 226 USPQ 428 (TTAB 1985). See also, *In re Sloppy Joe's International Inc.*, 43 USPQ2d 1350 (TTAB 1997); and *In re Kayser-Roth Corp.*, 29 USPQ2d 1379 (TTAB 1993).

The Examining Attorney must accordingly establish a prima facie case that the mark falsely suggests a connection with the tribe Pueblo of Sandia, New Mexico. See *In re Pacer Technology*, 338 F.3d 1348, 67 USPQ2d 1629 (Fed. Cir. 2003), and cases cited therein.

The Examining Attorney contends that in The Columbia Gazetteer of North America (2000) "sandia" is defined as "pueblo," which is a recognized tribe as shown in the publication "American Indian Reservations and Trust Areas," by Veronica E. Velarde Tiller (1996) ("Tiller publication"), and thus the term is the same as or an approximation of the name of the Indian tribe. Applicant contends that the correct name of the federally recognized tribe is "Pueblo of Sandia, New Mexico"; that applicant's mark SANDIA is not the same as or an approximation of this tribe's name as applicant's mark does not include the significant word "Pueblo," which refers to one of 19 Pueblo

tribes (e.g., "Pueblo of Acoma, New Mexico," "Pueblo of Cochita, New Mexico," "Pueblo of Picuris, New Mexico," "Pueblo of Taos, New Mexico," "Pueblo of Zia, New Mexico,"); and that the name of the tribe includes the significant geographical term "New Mexico," which is excluded from applicant's mark.

The Examining Attorney contends that the term SANDIA is recognized as the name of the tribe (i.e., the word SANDIA points uniquely to the Pueblo of Sandia, New Mexico tribe) as shown on the tribe's website where it refers to itself as "the Sandia people" and the Tiller publication (p. 459) refers to "the people of Sandia" and "Sandia Pueblo"; and that other uses of "Sandia" (e.g., Sandia Mountain Wilderness, Sandia National Laboratories) "merely extend the fame of the tribe." (Brief, p. 6.) Applicant contends that the Examining Attorney has not established that the word SANDIA is recognized by the consuming public as pointing uniquely to the Pueblo of Sandia, New Mexico tribe because "Sandia" is only part of the tribe's name; the term translates from Spanish as "watermelon"; the term is used in the name of the Sandia Mountain Wilderness created by Congress in 1978 and run by the U.S. Forest Service, the Sandia National Laboratories located in Albuquerque, New Mexico and Livermore, California

(government owned, contractor operated facilities), the name of a town in Texas as well as the town in New Mexico; and the term SANDIA is used as a trade name (over 100 listings in the Sandia, New Mexico telephone directory).⁴

Both applicant and the Examining Attorney agree that there is no connection between the Pueblo of Sandia, New Mexico tribe and applicant.

The Examining Attorney contends that if applicant's goods (cigarettes) are of a type that the person or institution sells or uses and the person is sufficiently famous, then it may be inferred that the purchasers of the goods would be misled into making a false connection of sponsorship, approval with the named party. Specifically, she argues that "many Indian tribes sell, market, and produce cigarettes and tobacco products"; that there is evidence that "the Sandia people operate or are affiliated with at least two smoke shops where they sell discount

⁴ Applicant also submitted evidence in the form of (i) the listing of several "hits" in a Google search of the term, (ii) a private database listing of several third-party applications and/or registrations for marks that consist of or include the word SANDIA for a variety of goods and services, and (iii) printouts from the USPTO's TESS system of 11 third-party applications and registrations for marks that consist of or include the word SANDIA for a variety of goods and services. This evidence is of little probative value and does not establish third-party use of the term SANDIA.

cigarettes";⁵ that "some of the tribes have reached beyond the tax and sale of cigarettes to produce those cigarettes"; that "the record is clear that the Sandia are affiliated with smokeshops, and it is clear that many Native Americans are engaged in the large-scale marketing of cigarettes and even their manufacture"; and that "Native American tribes are well known for having a sovereign legal authority to impose their own taxes, or as is more common in the case of cigarettes and other tobacco products, to offer those goods for sale 'tax-free.'" (Brief, p. 7.)

The Examining Attorney concludes (brief, p. 8) that applicant's evidence of the various places and/or businesses with the name "Sandia" shows that the Sandia people "are sufficiently famous to lend their name to the nearby mountains, towns and businesses."

Applicant argues that the Examining Attorney has not established that the Pueblo of Sandia, New Mexico tribe is of sufficient fame that when SANDIA is used on applicant's goods, a connection with the tribe would be presumed as

⁵ The two smoke shops which reference the Pueblo of Sandia, New Mexico tribe are (i) www.mailmesmokes.com, which states therein that this is an incomplete list of the "reservations that may sell you cigarettes online" and it then lists almost all Native American reservations in all 50 states, and (ii) www.bienmur.com, which lists "smoke shop" as well as, inter alia, "casino" and "online store" for the Bien Mur Indian Market Center ("owned and operated by the Pueblo of Sandia").

there is no evidence that the tribe or any enrolled member is involved in the manufacture or sale of cigarettes; that the fact that other tribes are so engaged is not relevant as it does not establish the required commercial connection of applicant's goods to the Pueblo of Sandia, New Mexico tribe; that the fact that cigarettes are sold on the Pueblo of Sandia, New Mexico reservation is not sufficient because cigarettes are ubiquitous; that the fact that the tribe is a sovereign entity that may tax cigarettes is not a sufficient connection as all sovereign entities may impose taxes on almost all goods and/or services, but that does not create the connection needed to establish a false suggestion of a connection; that there is no evidence that tobacco is grown or that cigarettes or other tobacco products are made by the tribe; that the cigarette industry is highly regulated as to advertising and labeling and applicant's label clearly shows a mountain, and not any Indian connection; and that there is no showing that the sale of cigarettes has any special connection to the Pueblo of Sandia, New Mexico tribe.

In addition, applicant points out that the Examining Attorney submitted a few pages from the website of the Bien Mur Indian Market Center (www.bienmur.com) wherein it states the following: "Sandia Pueblo is perhaps the least

known and understood of the dozens of cultures that once dominated the Rio Grande Valley." Thus, applicant argues there is not sufficient fame that a connection with the Pueblo of Sandia, New Mexico tribe would be presumed by consumers.

We have carefully reviewed all of the evidence in this case. As to the first prong of the test under Section 2(a) false suggestion of a connection, applicant's mark must be shown to be the same or a close approximation of the tribe's name. The record shows that there are numerous Pueblo tribes; that the name of one of those tribes is Pueblo of Sandia, New Mexico; and that the "Sandia, New Mexico" portion of the tribe name refers to the geographical location of the tribe. It cannot be said that SANDIA specifically names the Pueblo of Sandia, New Mexico tribe.

We are aware of the Board decision In re Julie White, 73 USPQ2d 1713 (TTAB 2004)⁶ in which the Board stated that "an applicant cannot take a significant element of the name of another and avoid a refusal by leaving one or more elements behind, provided that that which has been taken

⁶ The Board affirmed the Examining Attorney's refusal to register the mark APACHE for cigarettes as the term falsely suggests a connection with the nine federally recognized Apache tribes.

still would be unmistakably associated with the other person." White, supra, 73 USPQ2d at 1719. However, in the case now before us, applicant does not seek to register the term "Pueblo," which is the name of several tribes. Rather, applicant seeks to register the term "Sandia," which is the name of the New Mexico town where one of the Pueblo tribes is located, and in fact "Sandia" has been used in numerous other contexts and has other meanings. We find that SANDIA per se does not name the Pueblo of Sandia, New Mexico tribe.

Although the refusal to register could be reversed on this basis alone, in the interest of providing a complete decision, we will also determine the other prongs of the test under the facts of this case.

With regard to the second prong of the test under Section 2(a) false suggestion of a connection -- that the mark SANDIA would be recognized as pointing uniquely and unmistakably to the tribe -- the record simply does not support that conclusion. The term "Sandia" has many other significant meanings, including the name of the mountain wilderness, the National Laboratories, and two towns. There are over 100 listings which include the word "Sandia" in their trade names for various businesses in the Sandia Telephone Directory. Also, the term is Spanish for

"watermelon." This record fails to show that the term "SANDIA" is unmistakably and uniquely associated with the Pueblo of Sandia, New Mexico Indian tribe by consumers. See *University of Notre Dame du Lac v. J.C. Gourmet Food Imports Co., Inc.*, supra.

There is no disagreement on the third prong of the test -- applicant is not associated with the Pueblo of Sandia, New Mexico tribe.

As to the last prong of the test under Section 2(a) false suggestion of a connection, the person's name or identity must be shown to be of sufficient fame that, when used on the involved goods, a connection between applicant and the tribe would be presumed by consumers. That is, we must determine whether the term SANDIA is of sufficient fame that a connection with the federally recognized tribe "Pueblo of Sandia, New Mexico" would be presumed by consumers of cigarettes. As explained previously, we cannot find on this record that "Sandia" specifically refers unmistakably and uniquely to the Pueblo of Sandia, New Mexico Indian tribe. Thus, the term is not famous as the name of the tribe such that a connection would be presumed. Moreover, evidence that some Indian tribes, but not the Pueblo of Sandia, New Mexico tribe, have produced and sold cigarettes is not persuasive evidence that

consumers would presume a connection between the Pueblo of Sandia, New Mexico tribe and cigarettes. Cigarettes are everyday consumer goods which are sold in every town and every state in the United States. The fact that tribes are sovereign entities with the power to tax (or allow "tax-free") goods and/or services is not evidence that consumers presume a connection between this particular Pueblo tribe and cigarettes. The fourth prong of the test is not met.⁷

Inasmuch as the ex parte record here does not establish that the mark SANDIA falsely suggests a connection with the Pueblo of Sandia, New Mexico tribe, we reverse the refusal to register. See *In re Los Angeles Police Revolver and Athletic Club, Inc.*, 69 USPQ2d 1630 (TTAB 2003). See generally, 3 J. Thomas McCarthy, McCarthy on Trademarks and Unfair Competition, §19:76 (4th ed. 2005).

Decision: The refusal to register under Section 2(a) of the Trademark Act is reversed.

⁷ Compare the case of *Buffett v. Chi-Chi's, Inc.*, supra, wherein the Board denied applicant's motion for summary judgment and found genuine issues as to the elements of a Section 2(a) claim. There was extensive evidence providing factual support "for opposer's allegations that the song 'Margaritaville' and [Jimmy] Buffett are well-known and that Buffet has attempted, through his commercial licensing program, publicity, and entertainment services, to associate the term 'MARGARITAVILLE' with the public persona of Jimmy Buffett." 226 USPQ at 430.